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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,175	09/12/2000	Mark Robert Sivik	7882X	6728

27752 7590 02/26/2003

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EXAMINER	
MRUK, BRIAN P	
ART UNIT	PAPER NUMBER
1751	9

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/660,175	SIVIK ET AL.	
	Examiner	Art Unit	
	Brian P Mruk	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) *16-31* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15 and 32-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *6* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-15 and 32-35 in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the method of making the product claimed in claims 16-31 are directly related to the detergent composition claimed in claims 1-15 and 32-35, and that the examination of claims 16-31 would not place an undue burden on the examiner. This is not found persuasive, because the method of making the product in instant claims 16-31 require a different search based on the process steps required to make the product (i.e. reacting an alcohol or alpha-olefin with an alkoxylated alcohol) which is not required for searching the composition claimed in instant claims 1-15 and 32-35. Furthermore, the examiner has established that the product as claimed can be made by another and materially different process (see Paragraph Nos. 3 and 4 in Paper No. 7). Thus, both an undue examination burden and separate status in the art based on different classification do indeed exist.

The requirement is still deemed proper and is therefore made FINAL.

2. This application contains claims 16-31 drawn to an invention nonelected with traverse in Paper No. 8. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Objections

3. Claims 8-10 are objected to because of the following informalities: In instant claim 8, the variable "R" should be amended to recite "R^2". Instant claims 9-10 are objected to for being dependent upon instant claim 8. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The heterocycle groups which contain ---A== in instant claim 9 is non-enabling when A is either an oxygen atom or $N(R^8)_1$. Specifically, the valency for the oxygen atom is not satisfied (i.e. an oxygen atom in a ring cannot contain three bonds), and a quaternary nitrogen atom in a heterocycle is not stable.

Claim 10 is rejected under 35 U.S.C. 112, first paragraph, for being dependent upon claim 9. Appropriate correction is required.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The heterocycle groups which contain ---A== in instant claim 9 is indefinite when A is either an oxygen atom or $N(R^8)_1$. Specifically, the valency for the oxygen atom is not satisfied (i.e. an oxygen atom in a ring cannot contain three bonds), and a quaternary nitrogen atom in a heterocycle is not stable.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, for being dependent upon claim 9. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 1-3, 13-15 and 32-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hatton et al, GB 2,158,080 A.

Hatton et al, GB 2,158,080 A, discloses detergent compositions containing alkylbenzyl poly(oxyalkylene) derivatives, as required by applicant in the instant invention (see abstract). Specifically, note Example 4, which discloses an alkaline powder dishwashing product containing 2% by weight of the nonionic surfactant of formula 1, 30% by weight of sodium metasilicate, 38% by weight of soda ash, 10% by weight of trisodium nitrilo triacetic acid powder, and 20% by weight of sodium tripolyphosphate, and Example 5, which discloses a liquid rinse aid formulation containing 25% by weight of the nonionic surfactant of formula 1, 10% by weight of dipropylene glycol, 1% by weight of N-lauroyl sarcosinate and 64% by weight of water, per the requirements of the instant invention. Furthermore, with respect to instant claims 32-35, the subject matter would have been obvious to the skilled artisan because the patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi et al, 218 USPQ 289; In re Pilkington, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the

determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 173 USPQ 685,688 (CCPA 1972).

11. Claims 1-6 and 32-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Billenstein et al, DE 2,556,544.

Billenstein et al, DE 2,556,544, discloses a machine dishwashing detergent composition comprising a nonionic surfactant with the following formula I:

R-O-(XO)n-C(CH3)3

wherein R is a branched or linear alkyl group containing 6-22 carbon atoms, X is a C2-C3 alkylene group, and n is a number between 5-50, as required by applicant in the instant invention (see page 1, lines 1-8). Specifically, note Examples 1-3, which disclose machine dishwashing detergent compositions containing 2-15% by weight of the nonionic surfactants, and various adjunct ingredients, per the requirements of the instant invention. Furthermore, with respect to instant claims 32-35, the subject matter

would have been obvious to the skilled artisan because the patentability of a product by process claim does not depend on its method of production and where the examiner has found a similar product, the burden rests with the applicant to prove that that product is patentably distinct. See In re Thorpe, 227 USPQ 964 (CAFC 1985); In re Marosi et al, 218 USPQ 289; In re Pilkington, 162 USPQ 145. "The lack of physical description in a product-by-process claim makes the determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not the process that must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad processes put before it and then obtain prior art products and make physical comparisons therewith." In re Brown, 173 USPQ 685,688 (CCPA 1972).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. 1. Claims 1-15 and 32-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 19-23 of copending Application No. 09/660,363. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims and claims 1-8 and 19-23 of copending Application No. 09/660,363 claim a composition comprising a similar ether-capped poly(oxyalkylated) alcohol compound with similar substituents (see claims 1(a), 2-8 and 19-23 of copending Application No. 09/660,363), per the requirements of instant claims 1-15 and 32-35. Therefore, one of ordinary skill in the art would have been motivated to modify claims 1-8 and 19-23 of copending Application No. 09/660,363 to arrive at claims 1-15 and 32-35 of the instant invention, since an artisan of ordinary skill in the art would have had a reasonable expectation of success to prepare a similar composition comprising an ether-capped poly(oxyalkylated) alcohol claimed in the instant invention with the composition claimed in copending Application No. 09/660,363.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

BM

Brian Mruk
February 24, 2003

Brian P. Mruk

Brian P. Mruk
Patent Examiner
Tech Center 1700